Attorney Docket RSW920030194US1

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Notice of Appeal Transmittal

In re application of Marcia L. Stockton

Serial Nbr: 10/666,483 Filed: September 19, 2003

For: Using Radio Frequency Identification with Customer Loyalty Cards to Detect and/or Prevent Theft and Shoplifting

Art Unit: 2876 Examiner: Lisa M. Caputo

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing please find:
1) a **Notice of Appeal**, Form PTO/SB/31, in the above-identified Application (1 page, in duplicate);
2) a **Pre-Appeal Brief Request for Review** (1 page); and
3) a **discussion paper** attached thereto (5 pages).

[X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **09-0461**. A duplicate copy of this sheet is enclosed.

[X] Any additional fees required under 37 C.F.R. §1.16.

[X] Any additional fees required under 37 C.F.R. §1.17.

Date: May 9, 2006
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CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that the above-identified papers, a total of 10 pages (including a duplicate copy of this cover page), are being facsimile transmitted to the Patent and Trademark Office at (571) 273-8300 on May 9, 2006.

Marcia L. Doubet
(Name of person sending paper or fee)

Marcia L. Doubet
(Signature of person sending paper or fee)

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In re application of Marcia L. Stockton			May 9, 2006
Serial Nbr:	10/666,483	Filed:	September 19, 2003
For:	Using Radio Frequency Identification with Customer Loyalty Cards to Detect and/or Prevent Theft and Shoplifting		
Art Unit:	2876	Examiner:	Lisa M. Caputo

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the Non-Final (third) Rejection in the Office Action mailed February 9, 2006 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Marcia L. Doubet

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GROUNDS OF REJECTION PRESENTED FOR REVIEW

The **first ground of rejection** presented for review is a rejection of Claims 1 - 2, 8 - 9, and 15 - 16 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,415,982 to Bridgelall et al. (hereinafter, "Bridgelall"), according to the Office Action mailed February 9, 2006 (hereinafter, "the Office Action").

The **second ground of rejection** presented for review is a rejection of Claims 3 - 7, 10, 12 - 14, 17 - 20, and 22 - 23 under 35 U.S.C. §103(a) as being unpatentable over Bridgelall in view of U. S. Patent 6,554,187 to Otto, according to the Office Action.

ARGUMENT

For expediency only, for the **First Ground of Rejection**, Applicant will discuss her independent Claims 1, 8, and 15 with regard to Claim 1, and for the **Second Ground of Rejection**, will discuss her independent Claims 4, 12, and 18 with regard to Claim 4. Applicant reserves the right to argue additional grounds, and in particular to explicitly argue separate patentability of the dependent claims, if this Petition is denied.

With regard to the **First Ground of Rejection**, Applicant respectfully submits that Bridgelall does not teach or suggest all of the recitations of Claim 1 for at least the reasons discussed herein and in Applicant's previously-filed Amendments dated August 5, 2005 and December 19, 2005. Claim 1 recites (emphasis added):

> A method of preparing information usable in theft detection using radio frequency identification ("RFID") technology, comprising steps of:
> for a current transaction, reading a customer identifier from a customer

loyalty card; and

during the current transaction, storing the customer identifier in an item-identifying RFID tag affixed to each of at least one items being paid for by a shopper in the current transaction, such that the item-identifying RFID tag affixed to each of at least one items possessed by the shopper can subsequently be searched to determine whether the at least one possessed items were paid for in the current transaction.

Suppose, for example, that a shopper pays for a 1-ounce bottle of perfume and a pair of gold earrings in a current transaction. According to Claim 1, a customer identifier is stored in the RFID tag affixed to each of these 2 items being paid for. If the shopper is honest, then the shopper possesses the same 2 paid-for items when the RFID tag affixed to each item possessed by the shopper is subsequently searched, and the customer identifier will be located in those RFID tags to indicate that the items to which the RFID tags are affixed were paid for. A dishonest shopper, on the other hand, might substitute a 2-ounce bottle of perfume for the paid-for 1-ounce bottle, and might slip an extra pair of gold earrings into her shopping bag. Because neither the 2-ounce bottle of perfume nor the extra pair of gold earrings was paid for, neither item has the customer identifier stored in the RFID tag affixed to the item. So, when the RFID tag affixed to each item possessed by the shopper (now, a 2-ounce bottle of perfume and 2 pairs of gold earrings) is subsequently searched, the customer identifier will be found only in 1 of the pairs of gold earrings. The subsequent search can therefore determine that the 2-ounce bottle of perfume and the extra pair of gold earrings were not "paid for in the current transaction".

The Office Action cites Bridgelall's "shopping tote 86" as an item being paid for. Applicant disagrees: what is being paid for is articles 85 contained within the shopping tote. Consider, for example, that an alternative to the shopping tote, as taught by Bridgelall, is "a

shipping container". Col. 6, lines 22 - 23. It is not reasonable to assert that a purchaser of articles pays for the shipping container as well; rather, the purchaser pays for the articles transported in the shipping container -- just as a shopper would pay for the articles 85 contained within the shopping tote (and the shopper perhaps reuses the same shopping tote on multiple shopping trips, just as a shipping container may be reused for multiple shipments). Bridgelall teaches that shopping tote 86 includes an RFID tag 88 (col. 6, lines 19 - 20) while articles 85 use one-dimensional bar codes 14 (col. 6, lines 16 - 17), and has no teaching nor any suggestion of storing any information into RFID tags affixed to each of the paid-for articles 85 -- and in particular, has no teaching nor any suggestion of storing therein a customer identifier read from a customer loyalty card.

Page 3, lines 17 - 20 of the Office Action state "... Bridgelall does teach that each of the articles 85 within the shopping tote 86 has a barcode 14 on it for identification ... Hence, the RFID tag on the shopping tote is correlated with the barcodes on the items within it". Applicant respectfully submits that her claim language does not specify anything about correlating items having barcodes to a different item having an RFID tag, and thus this assertion is irrelevant to Applicant's claimed invention. Furthermore, Applicant also notes that, if the articles 85 are removed from the shopping tote 86, there is no longer any correlation, because Bridgelall has no teachings of storing any information to identify articles 86 into the RFID tag 88 of the shopping tote. Thus, this "correlation" is a mere unfounded assertion of the Examiner.

Applicant also notes that Bridgelall explicitly states "The term 'RF ID' refers to reading an RF ID tag" (col. 7, lines 7 - 8, emphasis added), and while Bridgelall discusses reading from RFID

tags, his text has no discussion or any suggestion of "during a current transaction, storing the customer identifier in an item-identifying RFID tag affixed to each of at least one items being paid for ..." (emphasis added).

Page 3, lines 15 - 17 of the Office Action admit that Bridgelall "does not explicitly teach the item-identifying RFID tag [affixed to each of the items being paid for] can be subsequently searched to determine whether the at least one items were presented for purchase". Applicant respectfully submits that Bridgelall also does not inherently teach these limitations (and Applicant notes that "presented for purchase" has been previously amended to recite "being paid for by a shopper"). Given that Bridgelall does not teach or suggest this limitation recited in Applicant's Claim 1, then Claim 1 is patentable over Bridgelall because, as stated in Section 706.02(j) of the MPEP, the combination must teach all the claim limitations. See also Section 2143.03 of the MPEP, "All words in a claim must be considered in judging the patentability of that claim ...".

With regard to the **Second Ground of Rejection**, Applicant respectfully submits that Bridgelall and/or Otto fail to teach or suggest all the recitations of Claim 4 for at least the reasons discussed herein and in Applicant's previously-filed Amendments dated August 5, 2005 and December 19, 2005. Claim 4 recites (emphasis added):

> A method of detecting potential theft using radio frequency identification ("RFID") technology, comprising steps of:
> reading, from a customer loyalty card possessed by a shopper, a customer identifier;
> searching, for each of at least one items possessed by the shopper, an item-identifying RFID tag affixed to the item to determine whether the customer identifier from the customer loyalty card was previously stored therein during a particular purchase transaction; and
> concluding that one or more selected ones of the items possessed by the

shopper were not paid for in the particular purchase transaction if the searching step fails to locate the customer identifier in the RFID tag affixed to the selected ones.

Neither Bridgelall nor Otto teaches these limitations of Claim 4 (emphasis added): (1) "searching, for each of at least one items possessed by the shopper, an item-identifying RFID tag affixed to the item to determine whether the customer number ... was previously stored therein ..." or (2) "concluding that ... selected ones of the items ... were not paid for ... if the searching step fails to locate the customer identifier in the RFID tag affixed to the selected ones". Regarding (2), Page 4, lines 14 - 17 of the Office Action admit that Bridgelall does not teach this recited claim language. The Office Action then cites col. 1, line 43+ and col. 2, lines 42+ of Otto for this teaching. Applicant respectfully disagrees. Col. 1, lines 43 - 45 of Otto state that an item may be classified as potentially stolen if the RFID label "does not contain purchase information". Applicant's Claim 4 specifies a "customer identifier", not "purchase information", and there is no basis in the prior art for asserting that a "customer identifier" is "purchase information" without use of prohibited hindsight reasoning. Furthermore, in col. 2, lines 42 - 45 and lines 51 - 52, Otto teaches that the purchase information of interest is "purchase information from [another] store". See also col. 2, line 63 - col. 3, line 1; **Fig. 2**, where the "Same Store?" test **50** must have a negative response before looking at purchase information **52**; and col. 4, lines 63 - 65.

Accordingly, Applicant's independent Claims 1, 4, 8, 12, 15, and 18 recite limitations not taught by the cited references. Accordingly, a *prima facie* case of obviousness has not been made out, and these claims are therefore deemed patentable over the references. Applicant's dependent claims are thereby deemed patentable by virtue of (at least) the allowability of the independent claims from which they depend.